Paper No. 23
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Miguel Torres S.A.
v.
Casa Vinicola Gerardo Cesari S.R.L.

Opposition No. 99,024
to application Serial No. 74/312,015
filed on September 8, 1992

On Remand From
The U.S. Court Of Appeals For The Federal Circuit

Robert G. McMorrow of Sughrue, Mion, Zinn, MacPeak & Seas for Miguel Torres S.A.

Fernanda M. Fiordalisi and Joseph Orlando of Bucknam & Archer for Casa Vinicola Gerardo Cesari S.R.L.

Before Simms, Hairston and Walters, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

The U.S. Court of Appeals for the Federal Circuit, in a decision dated December 7, 1999, vacated the Board's December 15, 1998 decision sustaining the opposition to registration of the mark shown below for wines and remanded the case for further consideration.

The remand is for the purpose of considering the appearance of the marks at issue and explaining why we gave little weight to the absence of evidence of actual confusion. In our decision, we failed to make specific findings about the appearance of the marks and to sufficiently explain our conclusion regarding the lack of any known instances of actual confusion.

Familiarity with the record and facts of this case will be presumed. However, for purposes of considering the appearance of the parties' marks, we have set forth opposer's marks below:

(1) TORRES in typed capital letters

(2)

(3)

There is no question that there are some differences in the appearance of the marks, i.e., the specific design elements in applicant's mark and opposer's TORRES and design mark as well as the stylization of opposer's TRES TORRES mark. On the other hand, we note that applicant's mark and opposer's TORRES and design mark both contain representations of towers. Further, it is a well established principle that likelihood of confusion may not be determined upon a side-by-side comparison of the marks. Such a comparison is not the ordinary way a prospective purchaser would be exposed to the marks. Rather, it is the similarity of the general overall commercial impression engendered by the marks which must be considered. This test requires us to consider the fallibility of human memory, and that the average purchaser normally retains a general rather than a specific impression of trademarks. See e.g., Geigy Chem. Corp. v. Atlas Chem. Indus., Inc., 438 F.2d 1005, 1007, 169 USPQ 39, 40 (CCPA 1971) and Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973).

On balance, the differences in the appearance of the marks do not outweigh the other relevant duPont[1] factors in

[1] In re E. I. duPont DeNemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973).

this case, namely, the strength of opposer's marks, the similarity in sound and connotation of the parties' marks,

and the identity of the parties' goods.

With respect to the absence of evidence of actual confusion, applicant offered the testimony of Gianfranco A. Carbone, eastern regional manager of Opici Wine Group, a distributor of applicant's wines. Mr. Carbone testified that as part of his duties, he visits retail stores and restaurants which sell applicant's wines; that on some of these visits he has noticed opposer's wines also for sale; and that he has not observed any confusion on the part of retailers or purchasers of the wines. Also, Mr. Carbone testified that in New Jersey there are retailers which purchase both opposer's and applicant's wines from his company; and that over a fifteen-year period he is not aware of any confusion on the part of these retailers.

There are several reasons we gave little weight to the absence of actual confusion evidence. First, Mr. Carbone's testimony lacks specificity in that there is no information regarding the number of retail stores and restaurants Mr. Carbone visited where he noticed both opposer's and applicant's wines being offered for sale. Also, there was no information as to how many New Jersey retailers purchase both opposer's and applicant's wine from Mr. Carbone's company. In the absence of the above information, we are unable to determine if there has been more than minimal opportunity for confusion to occur. Also, even if confusion

had occurred, it is not clear that this would have been reported to Mr. Carbone in his position as manager of a wine distributor. In particular, to the extent that some of the "purchasers" referred to by Mr. Carbone were restaurant patrons and/or wine store shoppers, it is unlikely that these individuals would have spoken to Mr. Carbone, instead of the waiter or store manager, concerning any confusion.

In view of the above, and for the reasons set forth in our prior decision, we remain of the opinion that confusion is likely in this case. As we stated in the prior decision:

> In sum, we conclude that consumers familiar with opposer's well known TORRES, TORRES and design, and TRES TORRES marks for wine and brandy, would be likely to believe, upon encountering applicant's DUE TORRI and design mark for wine, that such goods emanate from or are otherwise sponsored by the same source. Even if they were to notice the minor differences in the marks, they may well believe that opposer is now selling a new wine (DUE TORRI) to complement its TORRES and TRES TORRES wines and brandy. (Decision, p. 9).

Decision: The opposition is sustained and registration to applicant is refused.

R. L. Simms

P. T. Hairston

C. E. Walters
Administrative Trademark Judges
Trademark Trial and Appeal Board